

GS-13 CASE(S) FOR REVIEW

PRE-PROGRAM EXAMINER

1ST REVIEW

OWENS

Additional Issues of interest.

How do I figure out component (b)(i) compounds?

Scope of the composition where compound component is described by what it is intended to do (activity) and not by what it is (structure, name, formula); seems to reach through that which is disclosed. carboxylic acid, resonance, isoflavones, carboxylic acid deriv

For example: is component (b)(i) intended to include compounds which increase expression of CFTR provided by affecting efflux via CA(2+)-dependent K(+) channels w/ emps such as 1-ethyl-2-benzimidazole or synthetic peptide CK4-MZGlyR.

Other emps w/ chloride channel activating properties include not only the substituted benzimidazole compound class, but some specific xanthine derivatives also mitomycin C.

* Method claims not specifically articulating... less of a problem. These composition claims w/ the functional language poses a 112 2nd issue (Missing critical element) Identity of (b)(i). Hard to treat condition when guessing what to administer. Actually composition & method seem problematic.

Review Worksheet to Determine the Quality of Examination Under PAP

Section 1 - Patent Examining Functions & Applicability

Serial Number and Action Identification for Reviewed Work

Function	GS-7	GS-8	GS-11	GS-12	GS-13+				
1(a). Checking applications for formal matters	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
1(b). Checking application for technological accuracy	Performs after Preliminary Instruction (Core)	Performs (Core)	Performs (Core)	Performs (Core)	Performs (Core)				
2. Treating disclosure statements & statements & claims for priority	Performs after Preliminary Instruction	Performs (Core)	Performs (Core)	Performs (Core)	Performs (Core)				
3. Analyzing disclosure & claims for compliance with 35 U.S.C. 112	Performs after Preliminary Instruction	Performs	Performs (Core)	Performs (Core)	Performs (Core)				
4. Planning field of search	Performs after Preliminary Instruction	Performs	Performs (Core)	Performs (Core)	Performs (Core)				
5. Conducting search	Performs after Preliminary Instruction (Core)	Performs (Core)	Performs (Core)	Performs (Core)	Performs (Core)				
6. Formulating rejections under 102/103 or determining how claims distinguish over prior art.	Performs after Preliminary Instruction	Performs	Performs (Core)	Performs (Core)	Performs (Core)				
7. Determining whether amendment introduces new matter.	Performs after Preliminary Instruction	Performs	Performs (Core)	Performs (Core)	Performs (Core)				
8. Determining whether restriction is proper.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
9. Determining operability/utility.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
10. Evaluating/applying case law as necessary.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
11. Evaluating sufficiency of affidavits/declarations.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
12. Determining whether appropriate line of patentable distinction maintained between applications &/or patents.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
13. Includes "why?" in 103 rejections.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				
14. Evaluating sufficiency of reissue oath/declaration.	Performs after Preliminary Instruction	Performs	Performs	Performs	Performs				

Wilson, James

Subject:

Administration of a compound that (performs an action) w no structure or chem name

MISSING CRITICAL ELEMENT

In the instant method, claim(s) _____ fail to particularly point out the identity of the active agent (compound) to be administered (to be used) in the instantly claimed method. The current claim language is drawn to administering a compound (or using a compound in a procedure) which is not described structurally/ formulaically/nomenclatorially; however, the active agent's (compound's) mode of action, function or effect requisite to practicing the claimed method is set forth. The claim is missing the critical element which is the particular or distinct identity of the active agent (compound) to be used in the method claimed. It is noted the claim is limited to what the administration or use of "a compound" is intended to accomplish rather than what the active agent (compound) actually represents as a chemical entity.

MISSING CRITICAL ELEMENT

In the instant compound/composition, claim(s) _____ fail to particularly point out the identity of the component described as _____ . The current claim language is drawn to an activity or desired property of a compound/composition. This language does not particularly or distinctly provide sufficient clarity regarding the structural/ formulaic/nomenclatorial identity of the chemical core applicants intend to represent as a component of the comp/compsn articulated in the claim.

Consider 112nd if not doing

2000. Inclusion of specific (b)(1) compound in dependent claim into independent claim would be more suitably considered in prior art